

REMARKS

Claims 21-39 are pending in this Application, of which claims 1-20 were previously canceled without prejudice or disclaimer, and claim 40 stands withdrawn. Accordingly, claims 21-39 are pending. Claim 36 has been amended. Adequate descriptive support for the present Amendment should be apparent through the originally-filed disclosure, noting that the amendment to claim 36 is made responsive to the Examiner's new ground of rejection against claim 36 under 35 U.S.C. §101. Applicants therefore submit that the present Amendment does not generate any new matter issue or any new issue for that matter. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are solicited pursuant to the provisions of 37 C.F.R. §116. If, for any reason, the Examiner concludes that the present Amendment and Remarks do not place the application in condition for allowance, the Examiner is respectfully requested to enter the Amendment to simplify issues for potential appeal.

The Final Office Action mailed December 9, 2009 rejected claims 26-30 and 36-39 under 35 U.S.C. § 101 as directed to non-statutory subject matter, and claims 21-39 as anticipated by *Barry et al.* (US 6,615,258) under 35 U.S.C. § 102(e).

The rejection of claims 26-30 and 36-39 under 35 U.S.C. § 101 is traversed.

The Final Office Action appears to merely recite form paragraphs relating to the "machine-or-transformation test," "mere field of use limitation," "insignificant extra-solution activity," etc., concluding that the "generating" and "forwarding" steps of the instant claims constitute "mere data transmission or recordation" and suggesting the inclusion of "some type of machine or apparatus in the insignificant extra-solution steps."

Significantly, Applicants previously amended independent claim 26 to recite that the steps of “converting...the retrieved invoice data by compressing the invoice data for storage in a database and creating key information for retrieving the compressed invoice data within the database” are performed “in a **processor**.” Similarly, independent claim 36 is currently amended (responsive to the new ground of rejection) to recite that “the invoice system... converting the retrieved invoice data by compressing the invoice data for storage in a database and creating key information for retrieving the compressed invoice data within the database, the invoice system accessing the database for retrieval of invoice data corresponding to the invoice document in response to the request message to generate a response message containing an image of the invoice document based on the retrieved invoice data” comprises a **processor**.

Clearly, a processor is a “machine or apparatus,” and fits squarely within the categories of subject matter available for patent under 35 U.S.C. § 101. However, the Final Office Action never addressed the amendment to claim 26, reciting a “processor.” Instead, the rejection was merely repeated and made final, giving Applicants no clue as to the Examiner’s view as to why a “processor” is deemed to fall outside the ambit of 35 U.S.C. § 101 and, thus, affording Applicants no opportunity to respond in a more meaningful manner, if necessary.

The response to Applicants’ arguments regarding the rejection under 35 U.S.C. § 101 appears, *in toto*, at the top of page 10 of the Final Office Action, *to wit*, “Applicants’ arguments filed **08.03.2009** have been fully considered but they are not persuasive.”

Due process requires, at a minimum, that Applicants are made aware of the Examiner’s rationale for not accepting a “processor” as a specific machine to which the claimed steps are tied, especially since this amendment appears to be in accordance with the Examiner’s suggestion to include “some type of machine or apparatus in the body of the claim”(Final Office Action-

page 4). Accordingly, if the Examiner maintains the rejection of the claims on this ground, the Examiner is respectfully requested to withdraw the finality of this Office Action¹ and state clearly and specifically why the rejection is not obviated by the insertion of a “processor” into the claims.

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 26-30 and 36-39 under 35 U.S.C. § 101.

The rejection of claims 21-39 under 35 U.S.C. § 102(e) as anticipated by *Barry et al.* is traversed.

Independent claim 21 recites, *inter alia*, “a conversion module configured to **compress** the invoice data for storage in a database and to **create key information for retrieving the compressed invoice data** within the database.” Independent claims 26 and 31 recite, *inter alia*, “**converting the retrieved invoice data by compressing the invoice data** for storage in a database and **creating key information for retrieving the compressed invoice data** within the database.” Independent claim 36 recites, *inter alia*, “the invoice system **converting** the retrieved invoice data by compressing the invoice data for storage in a database and **creating key information for retrieving the compressed invoice data** within the database.”

Barry et al. does not disclose these features.

As explained in Applicants’ previous response, at col. 46, lines 8-15, *Barry et al.* performs a conversion process and stores converted data on tape, there is no disclosure of “**compressing** the invoice data for storage in a database” or “**creating key information** for

¹ Withdrawal of finality may be based on one or both of the following: 1. A new ground of rejection was applied to claim 36 not necessitated by any amendment of Applicants, and 2. The Examiner failed to respond to the Amendment of claim 26 with regard to a “processor.”

retrieving the compressed invoice data.” Accordingly, *Barry et al.* cannot anticipate the instant claimed subject matter.

At pages 10-11 of the Final Office Action, allegedly responsive to Applicants’ arguments, it is asserted that *Barry et al.* “discloses a Web-based, integrated customer interface system for data management,” and that the reference discloses data management products and services include “1) report requestor, report viewer, and report management applications enabling a customer to request, specify, customize, and schedule delivery of reports...2) centralized inbox system for providing on-line reporting, presentation, and notifications...3) an operational data storage system...4) a trouble ticket tool enabling a customer to open and monitor trouble tickets...5) a Web-based invoice reporting system allowing the customers access to their billing and invoice reports...6) an Internet “online” order entry and administration service to enable customers to manage their accounts; and 7) a system for handling security and authentication requests from both client and server side of the applications...”

Further, at page 11 of the Final Office Action, the Examiner asserted, with regard to calculations performed on figures selected from an invoice document, the Report Manager 250 of *Barry et al.* includes and provides access to metadata used to tell the Report Requestor what a standard report should look like and what options are available to the user. Moreover, at page 11 of the Answer, the Examiner asserted, responsive to Applicants’ argument regarding no teaching by *Barry et al.* of highlighting figures on an image of an invoice document and performing arithmetic operations on those highlighted figures, the report viewer application 215 of *Barry et al.* is able to accept messages instructing it to display an image or text that may be passed by one of the applications in lieu of report data.

Thus, none of the Examiner's arguments in the Final Office Action are responsive to Appellants' assertions that there is no disclosure of "**compressing** the invoice data for storage in a database" or "**creating key information** for retrieving the compressed invoice data" in *Barry et al.* Applicants continue to maintain that *Barry et al.* lacks any teaching of these specific claim features and that the Examiner has failed to establish a *prima facie* case of anticipation for at least this reason. The assertion in the Final Office Action, at page 5, that "the online invoicing server typically performs a conversion process and stores the converted data on tape until an audit approval" is unsubstantiated by any evidence of record regarding what is "typical" in an online invoicing server. Moreover, even if true, which Applicants do not admit, there is still no evidence in *Barry et al.*, nor has the Examiner identified such, regarding "**creating key information** for retrieving the compressed invoice data"

Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 21-39 under 35 U.S.C. § 102(e).

Additionally, claims 24, 29, 34, and 39 are patentable separately from the independent claims from which they depend.

Claims 24, 29, and 34 recite "wherein the host supports selecting figures presented in the invoice document for **performing an arithmetic operation on the selected figures.**" Claim 39 recites "**highlighting** figures on the image of the invoice document; and **performing an arithmetic operation of the highlighted figures.**" These features are not disclosed in *Barry et al.*

At page 7, the Final Office Action referred to "figure 56" (presumably, Fig. 17 was intended) and online invoicing server 1350 storing documents from different billing systems and

performing various database queries and function calls in response to requests received from the customer via the online invoicing proxy 1340, as disclosing the feature of **“wherein the host supports selecting figures presented in the invoice document for performing an arithmetic operation on the selected figures.”** In particular, the Final Office Action asserted, “the online invoicing server 1350 is responsible for tasks including data collection, calculation, storage and report generation.” Although, the portion of *Barry et al.* relied on is not cited, it is presumed that the Final Office Action is referencing col. 44, lines 64-67.

The disclosure of *Barry et al.* is merely that online invoicing server 1350 is responsible for tasks that include “calculation.” It is noted, again, that while the Final Office Action, and *Barry et al.*, at col. 44, line 67, refer to Fig. “56,” the figures described in the reference only extend to Fig. 27(b). There is no Fig. 56.

In any event, the mere disclosure of some generic “calculation” by an online invoice server in *Barry et al.* is clearly not a disclosure of “wherein the host supports selecting figures presented in the invoice document for performing an arithmetic operation on the selected figures.” *Barry et al.*, in no way, suggests that any calculation is **performed on figures selected from the invoice document**, as claimed. The Examiner’s reference to Report Manager 250, at page 11 of the Final Office Action, as providing access to metadata used to tell the Report Requestor what a standard report should look like and what options are available to the user, does not cure this deficiency in *Barry et al.* because Report Manager 250, while providing access to metadata, does not provide for “selecting figures presented in the invoice document for performing an arithmetic operation on the selected figures,” as claimed.

Further, this cited portion of the reference clearly suggests nothing relative to **highlighting figures** on an image of an invoice document and performing an **arithmetic**

operation on those highlighted figures. At page 11 of the Final Office Action, the Examiner asserted that highlighting figures on an image of an invoice document and performing arithmetic operations on those highlighted figures, is suggested by the report viewer application 215 of *Barry et al.*, which is able to accept messages instructing it to display an image or text that may be passed by one of the applications in lieu of report data. The mere display of a message or text does not correspond to **“highlighting figures on the image of the invoice document,”** as recited, for example, by claim 39.

Accordingly, since *Barry et al.* lacks any teaching of the above-argued features, it cannot and does not anticipate the subject matter of the instant claims. Therefore, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 21-39 under 35 U.S.C. § 102(e).

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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